34. The method of claim 33 wherein the third payout table is different from the first payout table and the second payout table.

35. The method of claim 31 wherein the first payout table and the second payout table are different.

36. The method of claim 32 wherein the first payout table and the second payout table are the same.

37. The method of claim 36 wherein the third payout table is different from the first payout table and the second payout table.

REMARKS CONCERNING THE AMENDMENTS

The above amendments have been made in an effort to more clearly define the present invention and to address issues raised in the Office Action. The majority of amendments address minor internal references within claims (e.g., "second hand of cards" and "both the" added to the claims, even though the meaning and presence of those terms was understood to already be in the claims. Additionally, the phrase "without having placed an additional bet" added to claims 1, 4 and 15 further clarifies the scope of the present invention, further emphasizing the meaning of the phrase "resolving the at least one bet".

Antecedent basis for new claims 31-37 may be found generally in the specification and, for example, in original claim 1, the examples, and Pages 12-14.

SUMMARY OF THE REJECTIONS

SUMMARY OF THE REJECTIONS

Rejections Under 35 USC 112, Second Paragraph

Claims 1-19 have been rejected under 35 USC 112, second paragraph. The same limitation in claims 1, 4 and 15 is asserted to lack clarity. That phrase is:

"...resolving the bet with respect to c)..."

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Rejections Under The Judicially Created Doctrine of Double Patenting

All claims have been rejected under a purported Judicially Created Doctrine of Double Patenting over the claims of U.S. Patent No. 6,179,711. It is believed that the rejection should be obviousness-type double patent as the basis for Double Patenting is not judicially created, but has been found by the courts to reside in 35 USC 101. Additionally, a Terminal Disclaimer is effective against Obviousness-Type Double patenting, but is not effective against Double Patenting.

Rejections Under 35 USC 103(a)

Claims 1-30 have been rejected under 35 USC 103(a) as unpatentable over Netley (US Patent No. 5,868,618) in view of Ornstein (US Patent No. 5,570,885). It is asserted that Netley teaches every limitation of the claims except for "paying for a parlay or consecutive winnings on hands." It is asserted that as Ornstein teaches a wagering gamne allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

RESPONSE TO THE REJECTIONS

Rejection Under 35 U.S.C. 112, Second Paragraph

Although a single term was referred to in the statement of the rejection in Paragraph 1 on Page 2 of the Office Action mailed May 21, 2002, that term is highly excerpted from the actual text. The language (with amendments presently added) actually reads:

> "...resolving the at least one bet with respect to whether a) the first hand exceeds a minimum rank in the payout table; b) the second hand exceeds a minimum rank in the payout table; and c) both the first hand of cards and the second hand of cards [exceeds] exceed a minimum in the payout table."

Read in its entirety, the language conveys a vastly different concept than the meaning considered in the rejection, even though the language is clear on its face.

Wagers (bets) in the field of gaming are resolved. That is, wins are paid, losses are withdrawn by the house, and 'pushes' (ties) are left in place. This is the clear meaning of the term "resolving" as used in the art and as used and explained in the specification. As noted in the claims and in this particular language, at least one bet

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(wager) is placed, and the final sequence of steps in the process is "resolving the at least one bet." The important aspects of this process that has not been appreciated in the interpretation of the claim are the facts that:

1) There must be two consecutive hands in each play of the game;

2) There must be three distinct events that must be resolved in the play of two hands.

The three distinct events that must be resolved according to the recitations of the claims are summarized as follows:

a) Exceeding of a minimum rank by the first hand (according to a payout table)

b) Exceeding of a minimum rank by the second hand rank (according to a payout table), and

c) Exceeding of a minimum rank by both the first and second hands (according to a payout table)

This resolution does not constitute a parlay or a bonus play. A parlay is where an amount that is initially put at risk and the amount won in a first event is carried into play (and usually placed at risk) in a second play. A bonus is where the occurrence of a first event (usually an elevated level of win) is required to get to a play where an additional (and often larger) payout may be obtained. In a bonus, the won amount may or may not be placed at risk. Each of those plays (parlay and bonus) is distinct from the play recited in the claims.

In the play of the present game, after the initial at least one bet has been made, there are two consecutive hands dealt. Both hands are dealt and both hands are played, irrespective of the events that occur in the other hand. This is therefore clearly neither a parlay (which requires winning amounts to be carried forth in a subsequent play) or a bonus (as there is no 'win' or special event needed in the first hand to enable play in the second hand.

In the play of the present game, an award is paid for 1) minimum ranks in the first hand, 2) minimum ranks in the second hand, and 3) minimum ranks in both hands. These are three distinct payments that are available in the play of two required hands in a single game. This is significantly different from what is taught in the art. The play of the game as represented by the claims is also abundantly clear.

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The claim clearly recites that the bet is resolved:

with respect to whether

a) the first hand exceeds a minimum rank in the payout table;

b) the second hand exceeds a minimum rank in the payout table;

and

c) <u>both the</u> first hand of cards and the second hand of cards <u>exceed</u> a minimum in the payout table

The claim clearly requires that all three events be resolved with regard to the at least one wager. The three events are not a Markush Group, or alternatives, but are three events for which resolution of the at least one bet must be made in the play of the game. The claim is in compliance with 35 USC 112, second paragraph.

(Obviousness-Type) Double Patenting

Claim 1 of U.S. Patent No. 6,179,711 is:

1. A method of scoring a video wagering game, the game comprising at least a first and second segment, the method comprising the steps of:
placing a wager to participate in a video wagering game;
playing the first segment of the video wagering game;
continuing play of the first segment until at least one predetermined condition has been met; ·
assigning a payout based on at least one winning outcome of the first segment;
playing the second segment of the video wagering game when the at least one predetermined condition has been met;
wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;
multiplying the payout of the first segment by the factor determined in the second segment; and
paying the enhanced payout to the player.

This rejection is not understood, as the games recited in the present claims are quite distinct from the elements of the method recited in the claims of U.S. Patent No. 6,179,711. Significant elements of the Patent claim that are not present in the play of the present method (in any claims) are highlighted.

The highlighted portions are not present in the recited method because:

continuing play of the first segment until at least one predetermined condition has been met;

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1) There is no predetermined condition that is a condition precedent for any additional play, as recited in the Patent claim.

playing the second segment of the video wagering game when the at least one predetermined condition has been met;

2) The second hand is always dealt and is always played in the presently claimed method. There is no condition precedent of "playing...when the at least predetermined condition has been met." The second set of symbols or the second game is always played.

wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;

3) The second game does not determine factors. The second game (e.g., the second set of symbols or second hand) is independently awarded on the basis of its rank according to the pay table. No factor is determined.

multiplying the payout of the first segment by the factor determined in the second segment;

4) There is no multiplication of the first award by a factor determined in the second game event. The first payout is not multiplied. That amount is paid out (resolved in step a) by itself. The other events are separately paid out.

It is absolutely clear that the two processes (of the patented claims and the present claims) do not overlap. The present claims could not have been recited in the Patent, as the present claims are a distinct invention not even within the generic scope of the claims of the Patent, and the subject matter of the present process was not disclosed in the specification of the patent.

The rejection for Double Patenting or Obviousness-Type Double Patenting is completely in error.

Rejection Under 35 USC 103(a)

It is asserted that Netley shows every element of the claimed invention except for "paying for a parlay or consecutive winnings on hands." It then is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

Netley does not show every element of the claims (the claim that is believed to be the broadest claim of this application, Claim 1, will be examined in this light), except for the parlay wager. In fact, Netley shows a traditional parlay type wager that is excluded

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from play of the present game. A side-by-side comparison of Netley and the claimed play (with comments) would be helpful in detailing the differences.

Claim 1 of Application	Netley Disclosure	COMMENTS
1. A method of playing a wagering game with at least two consecutive plays comprising:	Netley has consecutive plays only after a win in a first hand and an election to wager on a second, bonus-type round.	The preamble requires the underlying game to have at least two consecutive hands. There may not be only an optional or bonus play.
Placing at least one bet;	At least one bet is placed.	Same step
receiving at least one first set of symbols from which a rank may be determined in reading the symbols;	Netley receives a hand of cards from which a rank may be determined.	Same step
determining the rank of the first set of symbols;	A rank is determined.	Same step
comparing the first set of symbols to a payout table;	A payout table is used to determine an amount of win	Same step
determining whether the rank of the first set of symbols exceeds a minimum rank in the payout table;	A minimum rank on the payout table is determined in comparison with the hand.	Same step
receiving at least a second set of symbols from which a rank may be determined without having placed an additional bet;	Netley provides a second hand only with a "win" in the first hand.	This step is a required, not optional step in the invention. Even with a win in Netley, this is optional. Without a win, there is no second hand.
determining the rank of the second set of symbols;	A rank is determined in the second hand.	Same Step
comparing the rank of the second set of symbols to a payout table;	A payout table is used to determine an amount of win	
determining whether the rank of said second set of symbols exceeds a minimum rank in the payout table;	A minimum rank on the payout table is determined in comparison with the hand.	
resolving the at least one bet with respect to whether a) the first set of symbols exceeds a minimum rank in the payout table;	The first bet of Notley is resolved with respect to the first set of symbols and the first pay table.	It is important to note that a distinct bet is made by Netley for the first hand and second hand. If the player wins the first hanf, he can "either accept payment...or....wager the amount on a second tier

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		poker hand. Col. 1, lines 45-52.
b) the second set of symbols exceeds a minimum rank in the payout table;	The distinctly separate second bet of Netley is resolved with regard to the second set of symbols.	The claims of the invention require that the at least first bet is resolved with regard to the second set of symbols.
and c) both the first set of symbols and the second set of symbols exceed a minimum in the payout table.	There is no third resolution in Netley. There are at most two resolutions on two hands. Payout for the first hand and payout for the second hand.	This concept of three payouts is absent from Netley. Netley is literally no more than a true parlay series of play, with an election of the amount to parlay.

It is absolutely clear from this comparison that Netley fails to show essential elements claimed in the broadest claim of the invention, particularly relating to the resolution of a first wager with regard to three specific and different payout tables and resolutions. That step is not shown by Netley, who essentially shows a modified parlay where winnings are optionally placed as a wager in an optional second hand, the second hand being available only where there is a win in the play of the first hand.

Ornstein does not overcome this deficiency. Ornstein shows a separate and independent wager made by a player on how many consecutive hands will be won. The first wager is on the game itself, and there is no second set of symbols automatically provided in that game, only a chance to participate in a sequential and separate game. This capability of playing separate, but sequential games is essentially available in almost all casino games, where the casino will allow players to continue play by placing additional money on the game. In addition to the normal play of the underlying game (a number of games are illustrated, such as roulette, craps, blackjack, video games, etc., column 1, lines 19-30), a separate wager may be made on how many consecutive wins the player will have. The player wins appropriate odds based on what number of consecutive wins the player wagers on and achieving that number of wins. The wager on this event is a side bet and the resolution of wagers is not based on the first at least one wager that determines the amount won in the underlying game. The same element that is missing from Netley is also absent from the teachings of Ornstein. The claims cannot be obvious from this combination of references as at least this limitation is absent from each

of the references. As the limitation is not present in either reference, the step cannot be obvious.

The rejection of claims under 35 USC 103(a) over Netley in view of Ornstein must fail for at least that reason.

CONCLUSION

Applicant has shown that all rejections of record are in error and should be withdrawn.

Applicants assume the application is now in proper order and in condition for examination. If the Examiner finds that certain issues may remain in this application, the Examiner is courteously invited to call the attorney of record, Mark A. Litman at 952.832.9090 to discuss those remaining issues.

Respectfully submitted,

MARK YOSELOFF

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Date: August 21, 2002

By: _____
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Amendment is being faxed to: BOX AMENDMENT, Assistant Commissioner for Patents, Washington, D.C. 20231 on August 21, 2002.

Mark A. Litman
Name

Signature

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